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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,850	02/14/2001	Steven Mark Gebert	BLD920000048US1	9299
24033	7590	11/18/2004	EXAMINER	
KONRAD RAYNES & VICTOR, LLP			CAMPBELL, JOSHUA D	
315 S. BEVERLY DRIVE			ART UNIT	
# 210			PAPER NUMBER	
BEVERLY HILLS, CA 90212			2179	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/782,850

Applicant(s)

GEBERT ET AL.

Examiner

Joshua D Campbell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-26, 28-40 and 42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-26, 28-40, and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed 08/18/2004.
2. Claims 1-12, 14-26, 28-40, and 42 are pending in this case. Claims 1, 15, and 29 are independent claims. Claims 13, 27, and 41 have been cancelled. Claims 4, 18, and 32 have been amended.

### ***Claim Objections***

3. The objection of claims 25-43 in accordance with 37 CFR 1.126 has been withdrawn due to proper correction.
4. The objection of claims 13, 27, and 41 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, has been withdrawn due to the cancellation of those claims.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-3, 5, 7-8, 10-17, 19, 21-22, 24-31, 33, 35-36, 38-42 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (hereinafter Rivette, US Patent Number 6,018,749, issued on January 25, 2000) in view of Barry et al. (hereinafter Barry, US Patent Number 6,606,165, filed on January 8, 1999).

**Regarding independent claim 1 and dependent claim 13**, Rivette discloses a method in which a source document and a layout document (image document), which specifies layout and format of the content, are received (column 3, line 30-column 5, line 12 of Rivette). These documents are then processed to determine formatting properties including page divisions for content (column 3, line 30-column 5, line 12 of Rivette). Rivette does not disclose that multiple page objects are generated that include source content and formatting properties for one page or that the page objects are rasterized to be rendered for output. However, Barry discloses a method in which a document is split into multiple page objects that contain the source content and formatting for one page and that the page objects are then rasterized to be output to a printer (column 1, line 24-column 3, line 11 of Barry). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Rivette with the

method of Barry because it would have simplified the use of an output device to render a multi-paged document.

**Regarding dependent claims 2 and 3,** Rivette discloses a method in which the source document is transformed into a result document in a second language, wherein it includes formatting properties (including page divisions) provided by the layout data structure, which is a separate document (column 3, line 30-column 5, line 12 of Rivette). Rivette does not disclose that multiple page objects are generated from the result document. However, Barry discloses a method in which a document is split into multiple page objects that contain the source content and formatting for one page (column 1, line 24- column 3, line 11 of Barry). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Rivette with the method of Barry because it would have simplified the use of an output device to render a multi-paged document.

**Regarding dependent claims 5 and 7,** Rivette does not disclose page objects which are in a third presentation language which is a page description language. However, Barry discloses a method in which a document is split into multiple page objects that contain the source content and formatting for one page in a different page description language (image bit-map) (column 1, line 24- column 3, line 11 of Barry). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Rivette with the method of Barry because it would have simplified the use of an output device to render a multi-paged document.

**Regarding dependent claims 8 and 10,** Rivette discloses a method in which the result document contains multiple page instances, which are all in the same language as the result document, which is a device independent language (column 3, line 30-column 5, line 12 of Rivette).

**Regarding dependent claim 11,** Rivette discloses a method in which source content is in a page description language (column 3, line 30-column 5, line 12 of Rivette).

**Regarding dependent claim 12,** Rivette discloses a method in which the result document contains multiple page instances, which are all in the same language as the result document, which is a device independent language (column 3, line 30-column 5, line 12 of Rivette).

**Regarding dependent claim 14,** Rivette discloses a method in which the source document does not indicate page divisions (column 3, line 30-column 5, line 12 of Rivette).

**Regarding independent claim 15 and dependent claims 16-17, 19, 21-22, and 24-28,** the claims incorporate substantially similar subject matter as claims 1-3, 5, 7-8, and 10-14. Thus, the claims are rejected along the same rationale as claims 1-3, 5, 7-8, and 10-14.

**Regarding independent claim 29 and dependent claims 30-31, 33, 35-36, and 38-42,** the claims incorporate substantially similar subject matter as claims 1-3, 5, 7-8, and 10-14. Thus, the claims are rejected along the same rationale as claims 1-3, 5, 7-8, and 10-14.

8. Claims 4, 6, 9, 18, 20, 23, 32, 34, and 37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (hereinafter Rivette, US Patent Number 6,018,749, issued on January 25, 2000) in view of Barry et al. (hereinafter Barry, US Patent Number 6,606,165, filed on January 8, 1999) as applied to claims 2, 15-16, and 31 above, and further in view of Sall (as found in the IDS - FOP: Formatting Object to PDF Translator (James Tauber, published in 1999)).

**Regarding dependent claims 4 and 9,** Rivette does not disclose that the source document language is XML and the result document language is XSL-FO based on a layout of an XSL stylesheet. However, Sall discloses a method in which an XML is converted to XSL-FO based on an XSL stylesheet (pages 1-2 of Sall). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Rivette with methods taught by Sall because this method was noted to be a potential replacement for typical desktop published due to formatting advantages.

**Regarding dependent claim 6,** Rivette does not disclose that the source document language is XML and the result document language is XSL-FO based on a layout of an XSL stylesheet. However, Sall discloses a method in which an XML is converted to XSL-FO based on an XSL stylesheet, then based on XSL-FO convert the document to a PDF (pages 1-2 of Sall). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Rivette with methods taught by Sall because this method was noted to be a potential replacement for typical desktop published due to formatting advantages. In addition to this it was

well known at the time the invention was made that both the format of PDF and MO:DCA are imaging formats that were readily and easily converted back and forth between each other.

**Regarding dependent claims 18, 20, and 23**, the claims incorporate substantially similar subject matter as claims 4, 6, and 9. Thus, the claims are rejected along the same rationale as claims 4, 6, and 9.

**Regarding dependent claims 32, 34, and 37**, the claims incorporate substantially similar subject matter as claims 4, 6, and 9. Thus, the claims are rejected along the same rationale as claims 4, 6, and 9.

### ***Response to Arguments***

9. Applicant's arguments filed 08/18/2004 have been fully considered but they are not persuasive.

Regarding the applicants' arguments on pages 10-15 regarding claims 1, 15, and 29 have been considered but are not persuasive. The source document of Rivette is the text referred to in the citations by the examiner from the Rivette patent, while the layout is the image of the document, which provides format and page breaks. When the Equivalence file is created the format of the image file, including the pagination, is incorporated into the text content, creating a file that contains format and content, which exists as a different page description language as a text file because it would be impossible for a basic text file to contain all the format and page breaks. Referring now to Barry, it is shown that it would have been obvious to break a multi-page document,



such as the one formed by the method of Rivette, into separate page nodes, all the while maintaining format in a separate page description language (bit-map) in order to simplify the ability of rendering the document to an output device. All of this information can be found in the citations of the references as shown in the above rejection.

Regarding the applicants' arguments on pages 15-16 regarding claims 2, 16, and 31 have been considered but are not persuasive. The source document of Rivette is the text referred to in the citations by the examiner from the Rivette patent, while the layout is the image of the document, which provides format and page breaks. When the Equivalence file is created the format of the image file, including the pagination, is incorporated into the text content, creating a file that contains format and content, which exists as a different page description language as a text file because it would be impossible for a basic text file to contain all the format and page breaks. All of this information can be found in the citations of the references as shown in the above rejection.

Regarding the applicants' arguments on pages 16 regarding claims 3, 17, and 32 have been considered but are not persuasive. The source document of Rivette is the text referred to in the citations by the examiner from the Rivette patent, while the layout is the image of the document, which provides format and page breaks. When the Equivalence file is created the format of the image file, including the pagination, is incorporated into the text content, creating a file that contains format and content, which exists as a different page description language as a text file because it would be impossible for a basic text file to contain all the format and page breaks. All of this

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information can be found in the citations of the references as shown in the above rejection.

Regarding the applicants' arguments on pages 17 regarding claims 5, 8, 19, 22, 33, and 36 have been considered but are not persuasive. The source document of Rivette is the text referred to in the citations by the examiner from the Rivette patent, while the layout is the image of the document, which provides format and page breaks.

When the Equivalence file is created the format of the image file, including the pagination, is incorporated into the text content, creating a file that contains format and content, which exists as a different page description language as a text file because it would be impossible for a basic text file to contain all the format and page breaks.

Referring now to Barry, it is shown that it would have been obvious to break a multi-page document, such as the one formed by the method of Rivette, into separate page nodes, all the while maintaining format in a separate page description language (bitmap) in order to simplify the ability of rendering the document to an output device. All of this information can be found in the citations of the references as shown in the above rejection.

Regarding the applicants' arguments on pages 17-18 regarding claims 10, 12, 24, 26, 36, and 38 have been considered but are not persuasive. The source document of Rivette is the text referred to in the citations by the examiner from the Rivette patent, while the layout is the image of the document, which provides format and page breaks. When the Equivalence file is created the format of the image file, including the pagination, is incorporated into the text content, creating a file that contains format and

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content, which exists as a different page description language as a text file because it would be impossible for a basic text file to contain all the format and page breaks. This Equivalence file may be imported into any program that allows ASCII text, thus is device independent. Because the PDL of Rivette is just plain text, importing the equivalence file into any program that only supports ASCII would render the equivalence file into plain text, the original format (column 4, line 60-column 5, line 12 of Rivette). All of this information can be found in the citations of the references as shown in the above rejection.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

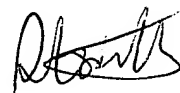
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC  
November 5, 2004



STEPHEN S. HONG  
PRIMARY EXAMINER